

Application No.: 10/619008

Case No.: 53867US01B

Remarks

Claims 1-7, 9-12, and 14-19 are pending. Claims 2, 3, 6-8, 10, 12-14, 16, and 17 are canceled (without prejudice to present the subject matter thereof in another application).

Claims 1, 4, 5, 9, 11, 18, and 19 are amended. Claims 20-23 are new.

Independent claim 1 has been amended to incorporate the limitations of original dependent claims 2 and 3, which require that the tacky component comprises a pressure sensitive adhesive comprising a (meth)acrylate polymer wherein the (meth)acrylate polymer is a copolymer of monomers comprising about 40 to about 100 weight percent of an alkyl (meth)acrylate and 0 to about 60 weight percent of a free radically copolymerizable monomer.

Claims 4 and 5 are amended to correct dependency.

Claims 9, 11, 18, and 19 are amended and rewritten in independent form to include all of the limitations of each base claim and their intervening claims.

Claims 20-23 are new and derived from canceled dependent claims 2, 6, 10, and 12, support for which can be found throughout the specification. Applicants submit that no new issues have been presented.

Allowed Claims

Applicants thank the Examiner for notification to the effect that claims 3-5, 7, 9, 11, 18, and 19 are objected to but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Additionally, Applicants acknowledge with gratitude the noted allowability of claim 15.

Final Rejection

Applicants respectfully request withdrawal of the premature final rejection in the Office Action dated December 1, 2004. The present Office Action includes a new ground of rejection with no statement or analysis that the new rejection was necessitated by amendment of the application by Applicants. The first time Burghart (WO 88/09185) has been used in a rejection of the instant application is in the present Office Action.

In view of the new grounds of rejection, it is respectfully requested that the finality of the present Office action be removed.

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§ 112 Rejection

Claims 1-7, 9-12, 14, and 17-19 stand rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. According to the Office Action, Applicants have not defined in the claims how much is considered an "effective amount."

In the present specification, Applicants have stated what is intended by an "effective amount" sufficient for one of ordinary skill in the art to determine an appropriate therapeutic dosage. For example, see page 22, II. 3-14, where effective amount is described as "an amount that constitutes a therapeutically effective amount varies according to a number of factors including the particular pharmacological agent(s) being used, the condition being treated, the characteristics of the host, any drugs being coadministered, desired duration of treatment, surface of the host at which the covering element is to be placed, other components of the fluid composition, and the like."

The present specification is also replete with description that would enable those of ordinary skill in the art to practice the full scope of that which is claimed. The purpose of the tacky component is clearly identified, and the description of the invention is functionally linked to this purpose, i.e. enough of the tacky component is present to allow the covering element to adhere to a substrate, but not so much that the covering element would be undesirably tacky, or that would impede the release of the therapeutic agents therefrom, if such agents are to included. Examples of suitable amount of the tacky components are provided (see, e.g. page 10, II. 15-17), as well as exemplary suitable weight ratios of the tacky component relative to the nontacky component (see, e.g., page 21, II. 6-9). Finally 82 working examples are provided describing differing amounts, and components of the tacky component.

Thus, the present specification sufficiently teaches those skilled in the art what constitutes an effective amount. Accordingly, reconsideration and withdrawal of the rejection of claims 1-7, 9-12, 14, and 17-19 under 35 U.S.C. § 112, second paragraph, is respectfully requested.

§ 102 Rejections

Claims 1, 2, 6, 10, 12, and 17 stand rejected under 35 USC § 102(b) as being anticipated by Burghart (WO 88/095185). Applicants believe that this rejection has been obviated by

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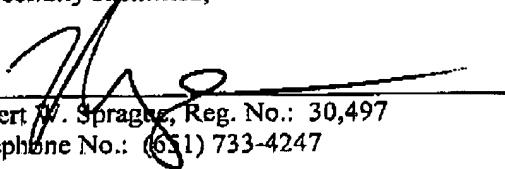
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amendment of claim 1 and the cancellation of claims 2, 6, 10, 12, and 17 without prejudice. However, Applicants expressly reserve the right to file a continuation application claiming the subject matter of the cancelled claims in the event Applicants wish to pursue such subject matter later.

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration of the application is requested.

Respectfully submitted,

1/31/05
Date

By: 
Robert W. Sprague, Reg. No.: 30,497
Telephone No.: (651) 733-4247

Office of Intellectual Property Counsel
3M Innovative Properties Company
Facsimile No.: 651-736-3833